

Remarks

This Application has been carefully reviewed in light of the Office Action, containing a restriction requirement, mailed December 14, 2004. Applicant provisionally elects with traverse to prosecute Claims 1-11 and 32 (Examiner's Group I). Applicant has withdrawn Claims 12-31 without prejudice or disclaimer; however, Applicant respectfully requests that if the Examiner withdraws the restriction with respect to any non-elected claims, the Examiner reinstate those claims. Applicant respectfully requests reconsideration of the restriction requirement in view of the following remarks.

I. The Restriction Requirement

The Examiner requires restriction to one of the following groups (*see* Office Action, paragraph 1):¹

- I. Claims 1-11 and 32 "drawn to a bill of materials sourcing system, classified in class 700, subclass 107;"
- II. Claims 12-22 "drawn to a method of for sourcing a bill of materials, classified in class 705, subclass 29;" and
- III. Claims 23-31, "drawn to software for sourcing a bill of materials, classified in class 707, subclass 10."

As an initial matter, Applicants note that the Examiner's statement that "the process can be practiced by hand" is not accurate. Independent Claim 1 clearly necessitates a sourcing engine and a transaction execution module to perform certain operations, independent Claim 12 clearly recites using a sourcing engine to perform certain of these operations, and independent Claim 23 clearly recites software to perform certain of these operations. Accordingly, the process cannot be practiced by hand.

More importantly, the Examiner has not satisfied the criteria for a proper restriction requirement. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (1) the inventions must be independent or distinct as claimed;

¹ Applicant notes that the Examiner refers to "channel allocation for cellular phones" and "a modular tracking and profile system," neither of which appears to have any relationship to Applicant's claims. (*see* Office Action, Paragraphs 3-4) Applicant assumes these references were unintentional. If Applicant is incorrect in this assumption, Applicant requests the Examiner to clarify these remarks.

and (2) there must be a serious burden on the Examiner if restriction is not required. M.P.E.P. § 803. Applicant respectfully submits that neither of these two criteria has been satisfied.

II. Groups I, II, and III Should be Examined in a Single Application

First, Applicant respectfully submits that the inventions in Groups I, II, and III are neither independent nor distinct. The term "independent" means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect. M.P.E.P. § 802.01. The claims of Groups I, II, and III clearly recite substantially similar limitations. For example, each element of the method recited in Claim 12 is recited substantially identically in Claim 1 as being performed by a sourcing engine and a transaction execution module and in Claim 23 as being performed by software. Also, the Specification discloses relationships among the subjects of Groups I, II, and III. (See, e.g., Page 6, Lines 9-24; Page 8, Line 3 through Page 9, Line 6). Thus, the inventions are not independent. The term "distinct" means that two or more subjects as disclosed are related, but are capable of separate manufacture, use, or sale as claimed, and are patentable, that is, novel and unobvious, over each other. M.P.E.P. § 802.01. The claims of Groups I, II, and III clearly recite substantially similar limitations, as shown above. Applicant respectfully submits that the Examiner would not consider the claims of either of Groups II and III to be novel and unobvious over Group I. By example, if a prior art reference disclosed the subject matter of Claim 1 of Group I in its entirety, Applicant respectfully submits that the Examiner would not consider Claim 12 of Group II or Claim 23 of Group III novel and unobvious over that reference. Thus, the inventions are not distinct.

Second, Applicant respectfully submits that the search and examination of the Application may be made without serious burden since the claims of Groups I, II, and III clearly recite substantially similar limitations, as shown above. "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803.

Although Applicant appreciates the opportunity to obtain multiple patents for the present invention, in light of the substantial similarities among the claims, as discussed

above, and the substantial costs associated with prosecuting multiple applications, Applicant must respectfully traverse the Examiner's restriction requirement.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the restriction requirement and examination of all pending claims together in this Application. Applicant reserves the right to petition the restriction requirement if the restriction requirement is made final.

Conclusion

Applicant believes this Application is in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests early and favorable action, including the full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this Application in any way, the Examiner is invited to contact Christopher W. Kennerly, the Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

Applicant believes that no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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